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EXAMINER

WEIS, SAMUEL

ART UNIT PAPER NUMBER

3691

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,255

Applicant(s)

HEINONEN ET AL.

Examiner

Samuel S. Weis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 August 1001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 09/02/01  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the application filed August 2, 2001. Claims 1-24 have been examined.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain "optimizing exchange of payment messages between the payment application and the payment server over an interface." The specification does not describe the quoted subjected adequately to enable one skilled in the art to make and/or use the invention.

5. Claims 2-12 and 14-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims are rejected because they are dependent on rejected independent claims for the reasons stated above.

Claims 8 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain "insuring operability of

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communication between the payment application and the payment server." The specification does not describe the quoted subject adequately to enable one skilled in the art to make and/or use the invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

8. Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "optimizing" in claims 1 and 13 is a relative term which renders the claims indefinite. The term "optimizing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "a message" in claims 1 and 13 is utilized in multiple limitations in the claims. The term "a message" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner cannot determine if the invention requires separate messages or just one. By not changing the antecedent from "a" to "the" in the second instance of "a message," the

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Examiner assumes, for examination purposes, that the second "a message" is a new message.

The term "first composite message" in claims 1 and 13 is a relative term which renders the claims indefinite. The term "first composite message" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner cannot determine the difference between "a message" and "first composite message."

The term "second composite message" in claims 1 and 13 is a relative term which renders the claims indefinite. The term "second composite message" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner cannot determine the difference between "a message" and "second composite message."

9. Claims 2-12 and 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected because they are dependent on an indefinite independent claim for the reasons stated above.

10. Claims 4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "based on" in claims 4 and 7 is a relative term which renders the claims indefinite. The term "based on" is not defined by the

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claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

11. Claims 8 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "operability" in claims 8 and 20 is a relative term which renders the claims indefinite. The term "operability" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

12. Claims 9 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "short" in claims 9 and 21 is a relative term which renders the claims indefinite. The term "short" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

13. Claims 10 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation includes the acronym USSD. The claims do not provide any explanation of the meaning of the acronym USSD. For

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purposes of applying prior art, the Examiner will interpret the acronym USSD to represent Unstructured Supplementary Service Data.

14. Claims 11 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation includes the acronym WAP. The claims do not provide any explanation of the meaning of the acronym WAP. For purposes of applying prior art, the Examiner will interpret the acronym WAP to represent Wireless Application Protocol. The Examiner will thus disregard the redundant "protocol" stated in the claims 11 and 22.

15. Claims 12 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation includes the acronym GPRS. The claims do not provide any explanation of the meaning of the acronym GPRS. For purposes of applying prior art, the Examiner will interpret the acronym GPRS to represent General Packet Radio Service.

16. Claims 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "basing" in claims 4 and 7 is a relative term which renders the claims indefinite. The term "basing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-8 and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. (hereinafter Davis), Pat. No. 6,282,522. Davis discloses a network payment system that utilizes a smart card for payment of goods and services purchased over the internet.

As to claims 1 and 13, Davis discloses a network payment method and system comprising:

optimizing exchange of payment messages between the payment application and the payment server over an interface (i.e. architecture and system that would allow a consumer to quickly and easily perform transactions over an open network such as the internet using a smart card) (col. 6, lines 12-15);

storing in the smart card client a message, from the payment application (i.e. draw request message) (col. 13, line 65 through col. 14, line 17);



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sending to the smart card server a first composite message comprised of at least one message (i.e. client terminal and merchant server exchange information via internet) (col. 13, lines 56-61);

storing on the smart card server a message to be transmitted over the telecommunication connection from the payment server to the payment application (i.e. payment server and merchant server communicate information directly between themselves) (col. 14, lines 18-25);

sending to the smart card client a second composite message comprised of at least one message (i.e. result message) (col. 14, lines 9-17).

As to claims 2 and 14, Davis discloses the step of sending a response message from the smart card client to the payment application (i.e. success message) (col. 17, lines 34-37).

As to claims 3 and 15, Davis discloses wherein the response message is formed as a message from the payment server (i.e. payment server sends debit command to client terminal) (col. 17, lines 12-16).

As to claims 4 and 16, Davis wherein the response message is based on a message received by the smart card client from the smart card server over the telecommunication network (i.e. client terminal accesses payment server using IP address received from merchant server and client server sends message to payment server) (col. 16, lines 53-58).

As to claims 5 and 17, Davis discloses the step of sending a response message from the smart card server to the payment server (i.e. it is also possible for the payment

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server and merchant server to communicate information directly between themselves) (col. 14, lines 18-25).

As to claims 6 and 18, Davis discloses wherein the response message is formed as a message sent by the payment application (i.e. client module sends success message to payment server) (col. 17, lines 39-43).

As to claims 7 and 19, Davis discloses wherein the response message is based on a message received by the smart card server from the smart card client over the telecommunication connection (i.e client terminal has already established communication with merchant server and payment server, links are used to exchange information between the payment server and the merchant server, rather than establishing a new link) (col. 14, lines 18-25).

As to claims 8 and 20, Davis the step of:  
insuring operability of communication between the payment application and the payment server (i.e. payment server communicates directly with a terminal) (col. 10, lines 54-57) by  
initiating a payment application transaction with an initiating transmission of payment message between the payment server and the payment application (i.e client terminal communicates with payment server, first by forwarding the draw request to the payment server) (col. 14, lines 4-7)  
after said initiating transmission, continuing transmission of payment messages via the smart card client and the smart cards server (i.e. message is then routed to merchant

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server via client terminal and merchant server then validates the result message) (col. 14, lines 12-14).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 9-10, 12, 21-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Skog (U.S. Pat. No. 5,930,701).

As to claims 9 and 21, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using short messages.

However, Skog teaches that data can be sent using short messages (col. 2, lines 29-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Skog within Davis for the motivation communicating using short messages.

As to claims 10 and 22, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using USSD protocol.

However, Skog teaches a method for enabling a mobile telecommunications network in which data can be sent over USSD (Unstructured Supplementary Service Data) protocol (col. 2, lines 29-35). Therefore, it would have been obvious to one of

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ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Skog within Davis for the motivation for communicating using USSD protocol.

As to claims 12 and 24, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using GPRS protocol.

However, Skog teaches a method for enabling a mobile telecommunications network in which data can be sent over GPRS protocol (col. 2, lines 29-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Skog within Davis for the motivation for communicating using GPRS protocol.

21. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Gershman et al (hereinafter, Gershman) (U.S. Pat. No. 6,199,099).

As to claims 11 and 23, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using WAP.

However, Gersham teaches a method for obtaining information utilizing a distributed communication network in which data can be sent over WAP (wireless access protocol) (col. 1, lines 44-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Gershman within Davis for the motivation for communicating using WAP.

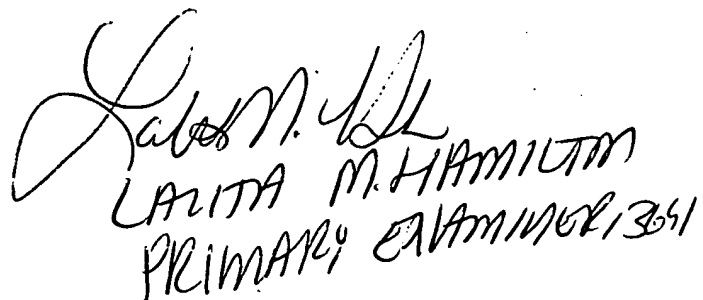
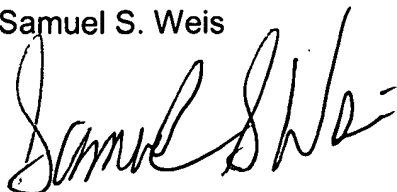
### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel S. Weis whose telephone number is (571) 272-2025. The examiner can normally be reached on 8:30 to 5, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Samuel S. Weis



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PRIMARY EXAMINER/3691